

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: Patrick J. Sweeney

Title: METHOD AND DEVICE FOR DELIVERING MEDICINE TO BONE

Appl. No.: 10/620,287

Filing Date: 07/15/2003

Examiner: Koharski, Christopher

Art Unit: 3763

Conf. No.: 7722

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT  
UNDER 37 C.F.R. §1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which was allowed on May 5, 2009.

The Patent Office determined that the patent was entitled to 643 days of PTA. Applicant believes that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of “overlap” are limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

Applicant has recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and has determined that the patent is entitled to 940 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 1106 days

(b) Total Applicant delay: 83 days

Final PTA Determination: 1023 days

Applicant therefore respectfully requests that the patent be accorded 1023 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicant requests further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date May 22, 2009

By /Jeffrey S. Gunderson/

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## Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 029815-0102  
 Application Number: 10/620287  
 Patent Number: N/A

|             | Event Description   | Event Date | Days from Filing | PTO Days   | Applicant Days |
|-------------|---|------------|------------------|------------|----------------|
| Edit Delete | Application Filing Date                                     | 07/15/2003 | 0                |            |                |
| Edit Delete | Notice to File Missing Parts                                | 10/14/2003 | 91               |            |                |
| Edit Delete | Response to Notice to File Missing Parts                    | 12/12/2003 | 150              |            |                |
|             | 14 month From Application date                              | 09/15/2004 | 428              |            |                |
| Edit Delete | IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO | 01/03/2005 | 538              |            |                |
| Edit Delete | IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO | 07/06/2006 | 1,087            |            |                |
|             | 3 Year Period Starts  | 07/15/2006 | 1,096            |            |                |
| Edit Delete | Restriction Requirement                                     | 09/11/2006 | 1,154            | (726)      |                |
| Edit Delete | Restriction Requirement Response Received at PTO            | 10/11/2006 | 1,184            |            |                |
| Edit Delete | Non-Final Office Action                                     | 11/01/2006 | 1,205            |            |                |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO                   | 01/11/2007 | 1,276            |            |                |
| Edit Delete | IDS under 1.704(c)(8) filed at PTO                          | 02/06/2007 | 1,302            |            | 26             |
| Edit Delete | Non-Final Office Action                                     | 03/07/2007 | 1,331            |            |                |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO                   | 05/17/2007 | 1,402            |            |                |
| Edit Delete | Final Office Action   | 07/27/2007 | 1,473            |            |                |
| Edit Delete | Request For Continued Examination                           | 09/26/2007 | 1,534            | (438) 1106 |                |
|             | 3 Year Period Stopped                                       | 09/26/2007 | 1,534            |            |                |
| Edit Delete | Non-Final Office Action                                     | 11/26/2007 | 1,595            |            |                |
|             | Non-Final Office Action + 3 months                          | 02/26/2008 | 1,687            |            |                |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO                   | 03/26/2008 | 1,716            |            | 29             |
| Edit Delete | Final Office Action   | 07/23/2008 | 1,835            |            |                |
|             | Final Office Action + 3 months                              | 10/23/2008 | 1,927            |            |                |
| Edit Delete | Final Office Action Response Received at PTO                | 10/23/2008 | 1,927            |            |                |
| Edit Delete | Advisory Action   | 11/14/2008 | 1,949            |            |                |
| Edit Delete | Request For Continued Examination                           | 11/20/2008 | 1,955            |            | 28             |
| Edit Delete | Non-Final Office Action                                     | 02/05/2009 | 2,032            |            |                |

|      |        |   |            |       |
|------|--------|---|------------|-------|
| Edit | Delete | Non-Final Office Action Rsp. Rcv'd at PTO | 03/12/2009 | 2,067 |
| Edit | Delete | Notice of Allowance                       | 05/05/2009 | 2,121 |
|      |        | Projected Patent Grant Date               | 11/17/2009 | 2,317 |
|      |        |   | Totals:    | 1,106 |
|      |        |   | PTA:       | 83    |
|      |        |   |            | 1,023 |

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Version: 3.02.05

LOGIN: Carolyn Simpson

IP: 10.50.33.22

Foley &amp; Lardner LLP